



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,297	07/05/2000	Dosuk D. Lee	04712/02000G	2121

7590 11/20/2003

Mary Rose Scozzafava, Esq.  
Hale and Dorr LLP  
60 State Street  
Boston, MA 02109

EXAMINER
----------

LEVY, NEIL S

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 11/20/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

EXAMINER
----------

ART UNIT	PAPER NUMBER
----------	--------------

26

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 7/2/03

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 4942, 43, 103, 111-151 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 4942, 43, 103, 111-151 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 43, 127, 128, 133, 135 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18, 21 of copending Application No. 09/993,739. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '739 application and current application claim variants, obvious, of the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 40, 42, 43, 103, 111-118, 120, 121, 127-131, 133-135, 138-146 are rejected under 35 U.S.C. 102(e) as being anticipated by Constantz-5962028.

The rejection of record is maintained. Applicants arguments require applicants limitations to terminology, without quantification. "Compressed materials" formed by rolling would be seen as resulting in a compressed product or object-applicant claims no

particular time, pressure shape or dimensions- constantly has it. Claim 3, mixes, presses and hydrates the same materials as applicant and achieve a high compressive strength composition. Shaped articles are also identified at col.4, lines 44-51. Although constants is stated to provide crystalline forms, the next paragraph shows the instant unquantified claim to "poorly crystalline" is acknowledged, as the same materials and ratios are disclosed. Claim 42 is seen in conjunction with added F, used as a dental component, known to enhance strength, hardness, fracture toughness.

Claims 40, 42, 43, 103, 111-118, 120-123, 125, 127-131, 133-147, 149-151 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constantz-5962028.

The rejection of record is maintained-again, constantz does provide poorly crystalline materials, while applicants claim to functional aspects and non-quantified aspects of the invention are seen as obvious over constants disclosure.

Claims 40, 42, 43, 103, 113-120, 126-128, 130-134, 138, 140-145 and 148 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al 6201039.

The rejection of record is maintained.

Contrary to applicants arguments example 12 refers to particles-the instant unquantified powders-we see no distinction. Also, open language permits of some other materials hydrated forms. Applicant hydrates, also.

Claims 40, 42, 43, 103, 111-151 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown or Constantz in view of Fukase et al '90 and Tung 5037639.

The rejection of record is maintained. Although Fukase and Tung do not compress, they do show the advantages of utilizing the instant materials, however they

Art Unit: 1616

are characterized, to enhance application of bone pastes and coments Tung does teach poorly crystalline (amorphous) Ca P.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 308-2412. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Levy/tgd  
November 13, 2003

  
NEIL S. LEVY  
PRIMARY EXAMINER